

Application No. 09/817,843  
Amendment dated February 23, 2006  
Reply to Office Action of November 23, 2005

IBM Ref.: END920000008US1

## REMARKS

### Status of Claims:

The present paper is submitted in response to the Office Action dated November 23, 2005 (Office Action). The Office Action was issued pursuant to the Decision, dated July 29, 2005, in Appeal No. 2005-1695, of the Board of Patent Appeals and Interferences. Claims 1-3, 17-21, and 35-37 were pending on appeal.

The Office Action erroneously addresses only Claims 1-3 and 35-37.

Claims 1-3, 17-21, and 35-37 are pending. Each of the pending claims defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

### Rejection Under 35 U.S.C. § 102(b):

Claims 1-3, 35, and 38 were rejected under 35 U.S.C. § 102(b) as being anticipated by Onda (JP-03296238).

Onda relates to a tape automated bonding (TAB) carrier. Claims 1 and 17 are hereby amended to recite "a ball grid array package further comprising:" to distinguish over Onda. Support for this recitation was present in the original disclosure at least in paragraph 20.<sup>1</sup>

Claims 1-3, and 35 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kurabe (6,291,081).

Rejection under 35 U.S.C. § 102 requires the prior art disclose each and every recitation of the claimed invention.<sup>2</sup> In determining anticipation, no claim recitation may

<sup>1</sup> See US 2002-0137256 A, the Pre-Grant Publication of the present application.

<sup>2</sup> See MPEP § 706.02.

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be ignored.<sup>3</sup> Anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims.<sup>4</sup> There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102.<sup>5</sup> The evidentiary record fails to teach each recitation of the present invention in view of the silence of Kurabe regarding contacting the substrate with the smooth side of the foil. Referring to Figure 6, Kurabe clearly shows that the matte side contacts the substrate.

**Rejections Under 35 U.S.C. § 103(a):**

Claim 37 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Onda.

Claims 36 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurabe.

To establish *prima facie* obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art. *In re Royka*.<sup>6</sup> All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*.<sup>7</sup> (MPEP § 2143.03). When evaluating the scope of a claim, every recitation in the claim must be considered. See e.g. *In re Ochiai*.<sup>8</sup> (MPEP § 2144.08). The evidentiary record fails to teach each recitation of the present invention.

The deficiencies of Onda and Kurabe have been discussed above.

**Conclusion:**

In view of the above, consideration and allowance are respectfully solicited.

<sup>3</sup> See *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

<sup>4</sup> See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); and *Alzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

<sup>5</sup> See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Stuhliengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

<sup>6</sup> *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

<sup>7</sup> *In re Wilson*, 424 F.2d 1382, 165 USPQ 496 (CCPA 1970).

<sup>8</sup> *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995).

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Accordingly, it is respectfully requested that the foregoing amendments be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

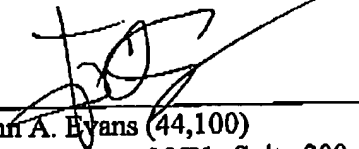
The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

The Director is hereby authorized to charge any fees, or credit any overpayment, associated with this communication, including any extension fees, to CBLH Deposit Account No. 22-0185.

Respectfully submitted,

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Date: February 23, 2006

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